

U.S. Serial No. 10/761,552 (Attorney Dkt: HALB:020D1)
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REMARKS/ARGUMENTS

I. General Remarks

Please consider the application in view of the following remarks.

II. Disposition of Claims

Claims 24, 33, 34, and 37-39 are pending in this application. In this Response, claim 24 has been amended.

III. Claim Rejections—35 U.S.C. § 112

The Examiner has maintained his rejections of claims 24, 33, 34, and 37-39 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner has stated that, “The amended endpoints of the ranges of percentages of the component of the continuous phase of the invert emulsion find no support in the original disclosure or claims. This is a new matter rejection.”

To explain his maintenance of his rejection further, the Examiner has stated:

Applicant argues that since the specification discloses a range of potential percentages of the components of the composition the amended endpoints—added in the previous claim amendment—is fully supported and the rejection is improper citing *In re Johnson and Farnham*, 558 F.2d 1008, 194 USPQ 187 (1977); however, in *In re Johnson and Farnham*, the court found that the applicant could not be limited to preferred embodiments when broader embodiments were disclosed. It is the position of the examiner that the applicant did not have possession, at the time of the invention, of the blend with the specific ranges recited for the components in the claims, as amended. See *Purdue Pharma v. Faulding, Inc.*, 56 USPQ2d 1481, 1487 (Fed. Cir. 2000) and MPEP 2163.05 III.

Applicants again respectfully traverse these rejections for the reasons stated in response to the previous office action, incorporated herein by reference, and for the further reasons set forth herein.

Although the Examiner has cited MPEP 2163.05 III in support of his position, this section states (emphasis added):

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With respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure. In the decision in *In re Wertheim*, 541 F.2d 257, 191 USPO 90 (CCPA 1976), the ranges described in the original specification included a range of "25%-60%" and specific examples of "36%" and "50%". A corresponding new claim limitation to "at least" had no upper limit and caused the claim to read literally on embodiments outside the "25% to 60%" range, however, a limitation to "between 35% and 60%" did meet the description requirement.

See also *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1328, 56 USPQ2d 1481, 1487 (Fed. Cir. 2000) ("[T]he specification does not clearly disclose to the skilled artisan that the inventors . . . considered the . . . ratio to be part of their invention There is therefore no force to Purdue's argument that the written description requirement was satisfied because the disclosure revealed a broad invention from which the [later-filed claims carved out a patentable portion]"). Compare *Union oil of Cal. v. Atlantic Richfield Co.*, 208 F.3d 989, 997, 54 USPQ2d 1227, 1232-33 (Fed. Cir. 2000)(Description in terms of ranges of chemical properties which work in combination with ranges of other chemical properties to produce an automotive gasoline that reduces emissions was found to provide an adequate written description even though the exact chemical components of each combination were not disclosed and the specification did not disclose any distinct embodiments corresponding to any claim at issue. "[T]he Patent Act and this court's case law require only sufficient description to show one of skill in the . . . art that the inventor possessed the claimed invention at the time of filing.").

To satisfy 35 U.S.C. § 112, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention." *Manual of Examining Procedure* § 2163.1 (hereinafter "MPEP"). "The examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims." MPEP 2163II.A.3.b. With respect to the § 112 rejections, the Examiner has indicated only that the particular claim limitations respecting the amended endpoints lack literal support in Applicants' disclosure, even though the endpoints are within the range disclosed in the specification. However, merely arguing lack of literal support in the disclosure is not sufficient to satisfy the Examiner's burden. See *In re Wertheim*, 541 F.2d 257, 265 (CCPA 1976) ("The PTO has done nothing more than argue lack of literal support, which is

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not enough.”). Accordingly, Applicants respectfully submit that the Examiner has not met the required burden.¹

Furthermore, regardless of whether the Examiner has not met the required burden, Applicants respectfully submit that there is literal support in the specification for claims 24, 33, 34, and 37-39. With respect to the terms “the esters comprise at least 50 weight percent and less than about 99 weight percent of the blend, the paraffin hydrocarbons comprise less than 50

¹ The Examiner has dismissed the case previously cited by Applicants, *In re Johnson and Farnham*, 558 F.2d 1008, 194 U.S.P.Q. 187 (CCPA 1977), as being directed, according to the Examiner, to not limiting an applicant “to preferred embodiments when broader embodiments were disclosed.” The undersigned counsel believes that the Examiner may have focused on a portion of that case dealing with claims other than ones of concern in the portion of the undersigned’s focus. Writing for the Court of Customs and Patent Appeals, Chief Judge Markey said at the end of the *Johnson* decision:

It is for the inventor to decide what *bounds* of protection he will seek.

...

In *Smith* the applicant sought the benefit of his prior application for a broadened generic claim, replacing the claim limitation “at least 12 carbon atoms” with a new limitation calling specifically for 8 to 36 carbon atoms, where there was no disclosure of either the range itself or of a sufficient number of species to establish entitlement to the claimed range. Appellants, in contrast to the applicant in *Smith*, are narrowing their claims, and the full scope of the limited genus now claimed is supported in appellants’ earlier application, generically and by specific examples.

The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species there within, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of § 112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute. All that happened here is that appellants narrowed their claims to avoid having them read on a lost interference count.

The board indicated that “it is manifestly immaterial” *why* appellants limited their claims. Though it is true that insufficiency under § 112 could not be cured by citing the causes for such insufficiency, it is not true that the factual context out of which the question under § 112 arises is immaterial. Quite the contrary. Here, as we hold on the facts of this case, the “written description” in the 1963 specification supported the claims in the absence of the limitation, and that specification, having described the whole, necessarily described the part remaining. The facts of the prosecution are properly presented and relied on, under these circumstances, to indicate that appellants are merely excising the invention of another, to which they are not entitled, and are not creating an “artificial subgenus” or claiming “new matter.”

In re Johnson and Farnham, 558 F.2d 1008, 1018-1019 194 U.S.P.Q. 187 (CCPA 1977)(emphasis added).

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weight percent of the blend and the isomerized olefins comprise less than 50 weight percent of the blend,” the specification as originally filed provides support for these terms. Support for these terms is found at least in paragraphs [0008], [0013], [0016], providing in pertinent parts that: “In blends of the invention with esters, the esters may be used in any quantity. Preferably, however, the esters should comprise at least about 10 weight percent of the blend and may comprise up to about 99 weight percent of the blend” and “When blended with esters of the invention, the paraffins should comprise at least about 1 weight percent to about 99 weight percent of the blend, but preferably less than about 50 weight percent. When blended with other hydrocarbons of the invention, particularly isomerized olefins, . . . the paraffins should comprise at least about 1 weight percent up to about 99 weight percent of the blend, but preferably less than about 50 weight percent of the blend.” Even the original title of the application emphasized “esters” by beginning, “Blends of Esters with” Accordingly, the range “wherein the esters comprise at least 50 weight percent and less than about 99 weight percent of the blend” is clearly encompassed within the broader range of “from about 1 weight percent of the blend up to about 99 weight percent of the blend” and is literally supported by the specification. The endpoint of “at least 50 weight percent” with respect to esters also has literal support, not only in blends with paraffins, but in the general discussion of the application throughout, which emphasizes “ester” blends.

Thus Applicants have clearly demonstrated that the Examiner has not met the required burden and that there is literal support in the specification for claims 24, 33, 34, and 37-39, and Applicants respectfully request withdrawal of these rejections.

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IV. Claim Rejections—35 USC § 103

The Examiner has maintained his rejection of all pending claims 24, 33, 34 and 37-39 as obvious from U.S. Patent No. 5,691,281 to Ashjian. Specifically, the Examiner has stated:

Ashjian teaches a method of drilling a wellbore comprising circulating a drilling mud comprising an invert emulsion (Column 1 Lines 5-65) comprising a base composed of a blend of 5 to 80 weight percent (Column 6 Lines 23-27) of a long chain isomerized olefin of at least 18 carbon atoms (Column 3 Lines 26-41) and 50 to 90 weight percent of n-paraffins, iso-paraffins and cycloparaffins of 10 to 18 carbon atoms (Column 3 Lines 51-59 and Column 6 Line 38-Column 7 Line 6) which may further comprise esters (Column 6 Lines 28-37) which, by difference, may comprise up to 45 weight percent of the blend.

Ashjian does not disclose expressly esters being present in a range of at least about 46 weight percent of the blend;

However, Ashjian obviates instant claims since there is no showing in the instant disclosure that the endpoint of the claimed range is critical and because it has been held that when the difference between a claimed invention and the prior art is the range or value of a particular variable, then a *prima facie* rejection is properly established when the difference in the range or value is minor—and certainly the difference between up to 45 weight percent and at least 46 weight percent, a difference of 1.6% of the entire claimed range, can be considered minor. See *Titanium Metals Corp. of Am. V. Banner*, 78 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985).

Generally, differences in ranges will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such range is critical. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Allen*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) and *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969).

Applicants respectfully traverse these rejections for the reasons stated in response to the previous office action, incorporated herein by reference, and for the further reasons stated herein.

Applicants have further amended claim 24 herein to specify that esters comprise at least 50 weight percent (and less than about 99 weight percent) of the blend used. Support for this amendment is set forth in the specification as discussed above in traversing the Examiner's rejections under 35 U.S.C. § 112.

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A basic tenet of patent law is that a prior art reference must be considered as a whole. This includes, but is not limited to, any teaching away by a reference. See, e.g., *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 U.S.P.Q. 416 (Fed. Cir. 1986); *Datascope Corp. v. SMEC, Inc.*, 776 F.2d 320, 227 U.S.P.Q. 838 (Fed. Cir. 1985).

The Ashjian reference makes one mention of the word “esters,” on line 29 of Col. 6², in a “throw-out” sort of manner suggesting at best that esters might be tried but were NOT the focus of the invention. In fact, by Ashjian not ever again discussing or even alluding to esters, Ashjian fails to provide enablement of the use of esters. Thus, with respect to esters, the Examiner can only use Ashjian for what is specifically disclosed therein and no more. *Symbol Technologies v. Opticon Inc.*, 935 F.2d 1569, 19 U.S.P.Q.2d 1241, 1247 (Fed. Cir. 1991). Therefore, the Examiner’s attribution to Ashjian of certain ranges of blend components respecting esters is improper and overreaching. Ashjian does not specifically teach any concentration range for esters. Further, there is nothing in Ashjian that would render Applicants’ invention predictable, as required for a finding of obviousness.

Contrary to the position of the Examiner, the law does not require a criticality to support Applicants’ claimed range, and any finding otherwise would be error. The cases cited by the Examiner do not hold otherwise, and are distinguishable from Applicants’ facts. *Titanium Meals* concerned anticipation of claims by a reference with nearly identical ranges as those in the claims in issue—0.3 and 0.8 compared to 0.25 and 0.75, and 0.31 and 0.94, respectively. In *In re*

² The single appearance of the word “ester” in the entire Ashjian reference occurs in the following context, from Col 6, lines 28-33 (emphasis added):

Although various combinations of hydrocarbons and other materials such as esters may be used, blends of the olefin isomers with (i) a light paraffinic oil with essentially no aromatic content and (ii) an olefin component, will normally give good blend viscometrics, flash point, bioacceptability as well as favorable product economics. In blends of this type, the mineral oil component is a mixture of C.sub.10 -

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Boesch, the range of the prior art and the claims in issue overlapped. The case *In re Allen* concerned a claimed process identical with the prior art except for lower temperature and high sulphuric acid concentration. In *In re Hoeschele*, the "teaching of the references encompass[ed] the invention defined by the claims" without evidence of critical significance.

The Examiner has admitted that Ashjian is not identical to Applicant's claimed invention. Applicants respectfully submit that a criticality is not needed. *In re Luvisi and Nohejl*, 342 F.2d 102, 133 U.S.P.Q. 646, 651 (C.C.P.A. 1965). In the words of the court in *Luvisi*, there is "no reason for requiring a showing of 'criticality,' whatever may have been intended by that term, of a limitation which finds support in the original disclosure, which is added to the claims for purposes of advancing prosecution of the application, and which is never alleged by the applicants to be 'critical.' If an applicant under these circumstances narrows the scope of his claims, he should be entitled to do so without being required to prove criticality."

SUMMARY

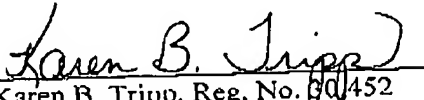
Applicants respectfully request that the Examiner withdraw his rejections based on the Ashjian reference. Applicants further respectfully request that the Examiner enter the amendments and allow the application to proceed to issue.

C.sub.18 n-paraffins and C.sub.10 -C.sub.32 olefins of low viscosity suitable for formulation into the well fluids after the addition of the olefin isomer component.

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Respectfully submitted,

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